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In the Supreme Court of the United States

OCTOBER TERM, 1964

No. —

EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
PETITIONER

v.

ANDREW JOHN MANSON

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

The Solicitor General, on behalf of the Commissioner of Patents, prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals entered in this case on June 25, 1964.

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (App., *infra*, p. 13) is reported at 333 F. 2d 234.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 25, 1964 (App., *infra*, p. 24) and a timely petition for rehearing was denied

on November 5, 1964. On February 3, 1965, the Chief Justice extended the time for petitioning for certiorari to and including March 5, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on certiorari a decision by the United States Court of Customs and Patent Appeals in a case on appeal from the Board of Appeals of the United States Patent Office.

2. Whether a process which produces a useless product is patentable.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8, clause 8, of the constitution of the United States provides:

The Congress shall have Power

* * * * *

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

* * * * *

28 U.S.C. 1256 provides:

Court of Customs and Patent Appeals; certiorari—

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or compo-

sition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

* * * * *

STATEMENT

On January 20, 1960, the respondent filed an application with the Patent Office for the purpose of provoking an interference with a patent issued on October 13, 1959 (the Ringold patent, U.S. Pat. No. 2,908,693) and establishing the priority of his discovery. Although the challenged patent and the interference application cover a complex new process for the production of a chemical compound, the technology is irrelevant for present purposes. The compound itself was apparently known to the professional literature before anyone developed the process in suit, but its utility was not yet established. The useful properties of the compound were first disclosed in the

Ringold application, on which the contested patent issued. The question is, therefore, whether respondent, who claims to have first discovered the process, can rightly be said to have made a "useful invention" by developing an original method of producing a chemical compound which, so far as appears, neither he nor anyone else knew to be useful until another (Ringold) rediscovered the process and demonstrated the utility of the end product.

The Patent Office Examiner rejected respondent's application on the ground that he had failed to show that the final product of the process for which he claimed a patent "was known to have any utility prior to the effective date of the reference [the Ringold patent]" (R. 55). The Board of Appeals concurred. It held that a process is not useful *per se* merely because it produces a known product; there must first be a demonstration of known utility for the product (R. 69). But the Court of Customs and Patent Appeals disagreed (App., *infra*, pp. 14-15):

Thus the board would require that before an applicant may have his claims to a new *process* placed in interference to determine the issue of priority of invention pursuant to 35 U.S.C. 135, he must show that a utility for the *compound* produced by the process was known at the time he invented the process. This requirement cannot be justified in view of 35 U.S.C. 101. As there defined, a process is a separate category of patentable invention. Clearly, a process which operates as disclosed to produce a known product is "useful" within the meaning of section 101. To add to this section the fur-

ther requirement that such a process is "useful" only when a "use" for a known end product is disclosed seems to us to be an improper arrogation of the authority delegated to Congress by the Constitution. Had such a restriction been intended by Congress, we believe it would have been directly stated either in section 101 or in the definition of a process found in section 100(b). We take the omission of any such requirement to be determinative of the issue here.

* * * * *

REASONS FOR GRANTING THE WRIT

In *Glidden Company v. Zdanok*, 370 U.S. 530, 578, n. 49, this Court left open the question whether decisions of the Court of Customs and Patent Appeals in patent cases are reviewable on certiorari. In briefs in opposition filed on behalf of the Commissioner of Patents since that decision we have suggested that resolution of the jurisdictional question should await a case presenting a patent issue independently worthy of review. The decision below, holding that a patent may be obtained on a process for the production of a useless product—a holding which is in direct conflict with the decision of the Court of Appeals for the District of Columbia Circuit in *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, certiorari denied, 355 U.S. 955—is, in our view, such a case. The decision, we submit, does violence to the constitutional and statutory standard of patentability and, if permitted to stand, undoubtedly will frustrate medical research and

scientific experimentation in the vital area of pharmacology.

1. In *Postum Cereal Co. v. California Fig Nut Co.*, 272 U.S. 693, this Court held that a decision of the Court of Appeals for the District of Columbia Circuit, on appeal from a determination of the Patent Office relating to a patent and trademark application, was not a judicial ruling, but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes"; accordingly the Court concluded that the decision presented no "case or controversy" within the constitutional jurisdiction of this Court. 272 U.S. at 698-701. That ruling was followed for a time after the jurisdiction of the Court of Appeals for the District of Columbia Circuit over patent and trademark matters was transferred to the Court of Customs and Patent Appeals.¹ See *Pacific Northwest Canning Co. v. Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and *McBride v. Teeple*, 311 U.S. 649 (patent case), in which this Court denied certiorari to review decisions of the Court of Customs and Patent Appeals "for want of jurisdiction," citing *Postum Cereal*.² Those decisions, however, no longer present an obstacle. Insofar as *Postum Cereal* rests on constitutional grounds, it was overruled in *Glidden Company v. Zdanok*, *supra*, 370 U.S. at 574-579, 605, n. 11. The subsisting question is a statutory one: whether

¹ Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475, 1476.

² In subsequent patent cases, the Court has merely denied certiorari, without more. *E.g.*, *Surrey v. Ladd*, 375 U.S. 930.

Congress intended to vest jurisdiction in this Court to review patent rulings of the Court of Customs and Patent Appeals.

Prior to 1948, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals related to customs cases. That provision—Section 195 of the old Judicial Code (36 Stat. 1145), as amended³—had two parts, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. In 1948, with the codification of Title 28 of the United States Code, the two jurisdictional provisions were separated; the first was redesignated Section 1541 and placed alongside the other provisions defining the competence of the Court of Customs and Patent Appeals (including Section 1542 granting it power to review Patent Office decisions); the second, authorizing this Court to review decisions of the Court of Customs and Patent Appeals, was redesignated Section 1256, part of the Chapter devoted to the jurisdiction of the Supreme Court.⁴ In the recodification, the language of the latter provision was substantially changed. Instead of confining certiorari jurisdiction in terms to “customs” cases, Section 1256 of the revised Judicial Code now broadly

³ Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

⁴ The Revisers’ Notes to Sections 1256 and 1541 confirm the derivation of those provisions.

provides for review by this Court of "[c]ases in the Court of Customs and Patent Appeals," apparently without limitation. The question is whether this change in wording, effected without comment by the Revisers or other indication of legislative purpose, is alone sufficient to warrant the conclusion that Congress meant to enlarge this Court's certiorari jurisdiction with respect to the Court of Customs and Patent Appeals.

Because of the absence of legislative history, we have, in the past, expressed doubt whether an expansion of the Court's jurisdiction was intended.⁵ We have recognized, however, that the jurisdictional question is important and should be resolved when presented in the context of a patent question independently worthy of review. This is such a case.

It is our present submission that the Court has jurisdiction. The broad language of 28 U.S.C. 1256 may fairly be read, we believe, as permitting review of all cases within judicial cognizance. Now that the constitutional obstacles have been removed, it seems proper to follow the statutory invitation to erase the old distinction between customs and patent cases.

⁵ See the briefs in opposition filed on behalf of the Commissioner of Patents in *Aubrey A. Larsen v. David L. Ladd, Commissioner of Patents*, No. 671, Oct. Term, 1961; *In the Matter of the Application of Andrew Alford*, No. 416, Oct. Term, 1962; *Karoline Cauer, et al. v. The Honorable Justices of the United States Court of Customs and Patent Appeals*, No. 268 Misc., Oct. Term, 1963; *Alexander R. Surrey, et al v. David L. Ladd, Commissioner of Patents*, No. 466, Oct. Term, 1963. *In the Matter of the Application of Friedrich Gruschwitz, et al.*, No. 579, Oct. Term, 1963.

Moreover, the issue of patentability reaches this Court in infringement proceedings and it would be anomalous to deny power to resolve the same question when presented by a more direct route. Much waste is avoided if this Court may, in some circumstances at least, bar the grant of an undeserved monopoly in a promising field for scientific or industrial experimentation.

Constitutional impediments aside, it seems improbable that Congress meant to perpetuate an unusual and harmful barrier to this Court's certiorari jurisdiction. Decisions of the Patent Office are reviewable, by somewhat different procedures, in either the Court of Appeals for the District of Columbia or the Court of Customs and Patent Appeals. Decisions by the former are reviewable on certiorari. Decisions by the latter should also be reviewable, not only to prevent an anomaly, but also to provide a method of eliminating conflict between the two courts.

2. On the merits, we agree with Chief Judge Worley's dissent. He observed that there is "no authority for the novel proposition that a process which produces a useless product is patentable" (App. 22). As the majority itself recognized (reiterating what had already been articulated in *Application of Bremner*, 182 F. 2d 216, 227), the Constitution (Art. I, § 8, cl. 8), as well as 35 U.S.C. 101 (requiring that an invention be "useful" to be patentable) and 35 U.S.C. 112 (requiring that the specification in the application for a patent set forth in exact terms such information as to enable someone "to make and use"

the invention), establishes as a condition precedent to the patentability of "products" a demonstration of utility. Unlike the majority below, however, we can find no basis, either in the Constitution or statutes, to differentiate between products and processes in this respect. Indeed, 35 U.S.C. 101, drawing no such distinction, expressly provides: "Whoever invents or discovers any new and *useful process*, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, * * *." [Emphasis added.]

To hold that useless discoveries may be rewarded with patent monopolies debases the principle that "[t]he function of a patent is to add to the sum of useful knowledge." *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Co.*, 340 U.S. 147, 152. Compare the government's pending petition in *United States v. Bert N. Adams*, No. 906. The development of a process for making a useless product adds nothing to the sum of useful knowledge. All that it does is, first, to enable the developer to block further research into the use of the product or to confine it to those whom he authorizes and, second, if a valuable use is discovered, to give him a monopoly of its manufacture in exchange for only half an invention.

The problem is of great importance in chemical research, especially in the drug industry. One who has invented nothing useful should not be put in a position to discourage, if not control, segments of important areas of medical or pharmaceutical research. Frequently processes for producing complex com-

pounds are developed even though the compound has no known use. Subsequent experimentation may show that the compound is a very valuable drug. That seems to be the case here. The process developed by respondent relates to what was subsequently revealed as a tumor-inhibiting drug. The rule adopted by the court below necessarily closes the door to experimentation with the same or similar processes by persons other than the patentee or those he authorizes. Discouraged by the broad patent which promises to rob them of any reward, those who might undertake the often costly search for beneficial uses of the product are diverted from the forbidden territory and a significant discovery may be lost or long postponed. An intent to risk such injury to the public welfare is not lightly to be inferred.

For these reasons the Patent Office has regularly refused to issue process patents where the product has no known use. Its view was approved by the Court of Appeals for the District of Columbia Circuit in *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, certiorari denied, 355 U.S. 955. Even if the question were not otherwise important, effective judicial administration would require a definitive settlement of the important and recurring question of patent law which divides the two courts with jurisdiction to review directly the decisions of the Patent Office with respect to patentability. See 35 U.S.C. 141, 145-146. An appropriate opportunity to resolve the question in the larger context of related patent problems is presented by other cases on the Court's calendar or pending on petitions

for certiorari. See *Graham v. John Deere Co.*, No. 580, certiorari granted, January 18, 1965; *Calmar, Inc. v. Cook Chemical Co.*, No. 778, petition pending; *Colgate-Palmolive Co. v. Cook Chemical Co.*, No. 810, petition pending; *United States v. Bert N. Adams*, No. 906, petition pending.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be granted.

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FEBRUARY 1965.

APPENDIX

United States Court of Customs and Patent Appeals
IN THE MATTER OF THE APPLICATION OF ANDREW JOHN
MANSON

October Term, 1963

Patent Appeal No. 7140

Serial No. 3,693

June 25, 1964

SMITH, Judge.

The single legal issue presented by this appeal is whether an applicant for a patent on a *new process* for making a *known compound* must establish a utility for such *compound*, in order to satisfy the requirements of Rule 204(b) preparatory to having an interference declared between his application and a prior patent.

It is unnecessary to encumber this opinion with any of the technical details of the process covered by appealed claims 2 and 3 of appellant's application.¹ These claims stand rejected as "obviously fully met" by a patent to Ringold et al.² Appealed claim 3 corresponds to claim 4 of the Ringold patent and was so written for the purpose of provoking an interference

¹ Serial No. 3,693, filed January 20, 1960, for "Preparation of Organic Compounds."

² No. 2,908,693, issued October 13, 1959, entitled "Production of 2-Methyl-Dihydrotestosterones."

with that patent. Appealed claims 2 and 3 differ only in scope and we shall therefore treat both claims as one for purposes of this opinion.

As required by Rule 204(b), appellant filed certain affidavits which purported to show that he was *prima facie* entitled to an award of priority of invention relative to the filing date of the Ringold patent. Among other things, these affidavits alleged that the compound produced by the claimed process was known in the art and that its utility was obvious to appellant at the time he invented the process. The examiner, however, took the position that the affidavits were deficient in that they did not clearly show a utility for the compound produced by the claimed process and thus that appellant had not shown that he had made a "useful" invention prior to the filing date of the Ringold patent. This position was summarized by the board as follows:

It does not appear that the Examiner questions the affidavits filed under the provisions of Rule 204(b) except as to the showing relative to the utility of the compounds produced by the process of claim 3. The issue presented is whether the affidavits are sufficient in the [this?] respect. * * *

The board, placing its reliance on language found in *inter partes* interference decisions dealing with what constitutes a reduction to practice of an invention, then concluded:

* * * we cannot agree that a process is *prima facie* useful merely because the product is disclosed in the literature unless the product was known to be useful.

Thus the board would require that before an applicant may have his claims to a new *process* placed in interference to determine the issue of priority of invention pursuant to 35 U.S.C. 135, he must show

that a utility for the *compound* produced by the process was known at the time he invented the process. This requirement cannot be justified in view of 35 U.S.C. 101. As there defined, a process is a separate category of patentable invention. Clearly, a process which operates as disclosed to produce a known product is "useful" within the meaning of section 101. To add to this section the further requirement that such a process is "useful" only when a "use" for a known end product is disclosed seems to us to be an improper arrogation of the authority delegated to Congress by the Constitution. Had such a restriction been intended by Congress, we believe it would have been directly stated either in section 101 or in the definition of a process found in section 100(b). We take the omission of any such requirement to be determinative of the issue here.

We had hoped that our views set forth in *In re Dickinson and Zenitz*, 49 CCPA 951, 299 F. 2d 954, 133 USPQ 39, as to the Commissioner's duties and responsibilities under the statutory provisions and the rules of practice here in issue, would have been considered as determinative of the issues here. While we agree with the board that the *facts* in the *Dickinson and Zenitz* case distinguish it from the *facts* here, we think what was there said is pertinent as to the basic legal right of the appellant to have the issue of priority of invention duly determined as provided in section 135. To the end that there shall be no mistake as to the portions of the *Dickinson and Zenitz* opinion which we think should have been applied in this case, they are quoted as follows (49 CCPA at 957-58):

There is no question but that under 35 U.S.C. 135, the Commissioner is required to initiate interference proceedings by giving notice to the

parties whenever, *in his opinion*, an application would interfere with any pending application or with any unexpired patent.

Further, under 35 U.S.C. 6, subject to the approval of the Secretary of Commerce, he "may establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office." Also, it is equally clear that, unless specifically prohibited by law, the Commissioner may delegate his duties.

On the other hand, in performing his duties, the Commissioner cannot usurp the functions or impinge upon the jurisdiction of the Board of Patent Interferences established by 35 U.S.C. 135.

In applying these principles to the case at bar, it is obvious that the Commissioner could promulgate a rule to cover the factual situation that is presented in this and similar cases. This he did in establishing Rule 204(b). Also, he could delegate to the Primary Examiner and the Assistant Commissioner his responsibilities under Section 135, and they could decide in the first instance whether a *prima facie* case had been presented by applicant.

* * * *

The "opinion" of the Commissioner that is required in Section 135 pertains to the factual question of whether the claims of the application would interfere with the claims of the patent, and whether a *prima facie* case has been alleged. The question of priority is to be determined by the Board of Patent Interferences and such factors, as what is necessary to show reduction to practice in a particular case, come within the exclusive jurisdiction of that board. It should be kept in mind, however, that a patentee ought not to be compelled to go through an interference proceeding without reasonable cause.

Although Rule 204(b) indicates that the required affidavit must be in the nature of that specified in Rule 131, obviously, any provision of Rule 131 which requires more than the statute contemplates in connection with a Rule 204(b) proceeding would not be applicable, as in the case at bar. * * *

In the *Dickinson and Zenitz* case we held that for purposes of a prima facie showing of actual reduction to practice of a chemical compound, the utility requirement of section 101 was satisfied by alleging merely that "the utility [of the claimed compound] was obvious to us at the time we submitted the compound for testing which was prior to August 16, 1955 [the critical date]." It is our opinion that, if the requirement of a prima facie showing of utility of a claimed compound may be satisfied by the statement that such utility was "obvious" at the time the invention was made, then *a fortiori* the requirement is satisfied where no question is raised as to the operability of the claimed chemical process to produce a known compound.

It seems clear from the present record that the Patent Office refused to accept appellant's affidavits on the philosophical basis that unless a compound is known to be useful, a process for making the compound is not useful under section 101 and hence not patentable. Thus the case of *In re Wilke and Pfohl*, 50 CCPA 964, 314 F. 2d 558, 136 USPQ 435, cited by appellant and argued by both parties, is not directly controlling here since it dealt with the adequacy of the specification with respect to a disclosure of "how to use" under section 112. *Wilke* is of value, however, in that it indicates the recent thinking of this

court with respect to utility issues. In *Wilke*, speaking to the section 112 issue, we said:

* * * We decline to apply to these process claims the statement in the *Bremner* case from which the Patent Office has extracted the so-called "rule of *Bremner*," i.e., that the specification must teach a use for the product of a claimed process. Had this been the intent of Congress, we are certain that it would have been so stated in 35 U.S.C. 112. * * *

The relevance of this statement to the present case seems clear. If, to be patentable, a process must not only produce a product but a product known or proved to be useful, then it follows that an application for a patent on such a process would have to disclose how to use the product. But the holding in *Wilke* is to the contrary. See also *In re Adams et al.*, 50 CCPA 1185, 316 F. 2d 476, 137 USPQ 333.

In the *Bremner* case [*In re Bremner et al.*, 37 CCPA 1032, 182 F. 2d 216, 86 USPQ 74, 75] this court said, "It was never intended that a patent be granted upon a product, or a process producing a product, unless such product be useful." That this statement is correct with respect to *product* claim is beyond doubt. 35 U.S.C. 101. As to whether a specification must show *how to use* the product of a claimed *process*, however, our holding in *Wilke* made it abundantly clear that it is not necessary so to do. In the present case, our holding that where a claimed process produces a known product it is not necessary to show utility for the product eradicates, as to process claims, whatever remained of the so-called "rule of *Bremner*" subsequent to our decision in *Wilke*. See also *In re Szwarc*, 50 CCPA 1571, 319 F. 2d 277. 138 USPQ 208.

Neither the solicitor nor appellant has cited a case, nor have we found any, which is contrary to our present holding. To be sure, in *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, 114 USPQ 94 (D.C. Cir. 1957), the court relied on the *Bremner* case in affirming a rejection of certain chemical process claims. However, as we pointed out in the *Szwarc* case, *supra*, the decision made no distinction between product and process claims and was based on the insufficiency of the disclosure of how to use the product produced by the claimed process *as required by section 112*. At any rate, for whatever the *Petrocarbon* case may be said to stand, we have already indicated, at some length, our disagreement with it in both the *Szwarc* case and *In re Nelson et al.*, 47 CCPA 1031, 280 F. 2d 172, 126 USPQ 242, and it would serve no useful purpose to labor the point further here.

The law regarding utility has enjoyed an uncommon stability over the years, in contrast to many other areas in the patent law. In the *Nelson* case, *supra*, we considered in some depth the ancient and persistent requirement of utility as a condition for patentability. As indicated by the many authorities there discussed, a process is "useful," as a matter of law, if it operates as disclosed to produce its intended result or perform its intended function and if it is not, in operation or result, detrimental to the public interest.

As long ago as 1817, in *Bedford v. Hunt*, 3 Fed. Cas. 37 (No. 1217) (C.C.D. Mass.), Justice Story articulated the basis for this general statement, when he said:

* * * By useful invention, in the statute, is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention, which is injurious to the morals,

the health, or the good order of society. It is not necessary to establish, that the invention is of such general utility, as to supersede all other inventions now in practice to accomplish the same purpose. It is sufficient, that it has no obnoxious or mischievous tendency, that it may be applied to practical uses, and that so far as it is applied, it is salutary. *If its practical utility be very limited, it will follow, that it will be of little or no profit to the inventor; and if it be trifling, it will sink into utter neglect. The law, however, does not look to the degree of utility; it simply requires, that it shall be capable of use, and that the use is such as sound morals and policy do not discountenance or prohibit.* * * * [Emphasis added.]

And again in the same year, in *Lowell v. Lewis*, 15 Fed. Cas. 1018 (No. 8568) (C.C.D. Mass.), Justice Story said:

* * * All that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word "useful," therefore, is incorporated into the act in *contradistinction to mischievous or immoral*. For instance, a new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention. *But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the interests of the patentee but of no importance to the public.* If it be not extensively useful, it will silently sink into contempt and disregard. * * * [Emphasis added.] [³]

³ In commenting on this language, one court has said that "A study of the cases reveals that the legal significance of 'useful' in the patent statute differs from the general conversational connotation of the word." *Cusano v. Kotler*, 159 F. 2d 159,

This basic rationale has persisted, unchanged, down to the present day, in this court as well as in the District of Columbia Circuit. As recently as 1961, the District Court for the District of Columbia stated, in *Commonwealth Engineering Co. v. Ladd*, 199 F. Supp. 51, 131 USPQ 255, 257:

This Court held in *Isenstead v. Watson*, 157 F. Supp. 7, 115 USPQ 408, that the term "utility" is a broad term and implies, among other things, capacity to perform the function or attain the result claimed by the applicant in his disclosure. It further held that, in connection with a composition of matter, the test of utility is whether the invention will attain the purpose and will operate as disclosed and claimed by the inventor. Similarly, *in connection with an invention consisting of a process or a method, the term utility must necessarily mean whether the process will operate as claimed and will produce the result intended by the inventor.* [Emphasis added.]

In the present case it is admitted that appellant's claimed process meets these requirements. It operates as claimed and produces the result intended by the inventor. In addition, it has not been shown to be contrary to sound morals and policy. To put it another way, appellant's process *works* and is not alleged to be detrimental to the public interest. Under such circumstances, appellant's affidavits under Rule 204(b) have made a legally sufficient *prima facie* showing as to his actual reduction to practice of the claimed process prior to the filing date of Ringold.

162, 72 USPQ 62 (3d Cir. 1947). In that case the court held that the creation of a new game conforms to the patent requirement of being useful.

See also *Callison v. Dean*, 70 F. 2d 55, 21 USPQ 240 (10th Cir. 1934), which held that a device which may be used for innocent amusement possesses utility.

He is, therefore, entitled under section 135 to a determination as to the issue of priority of invention.

The decision of the board is *reversed*.

Reversed.

WORLEY, Chief Judge, dissenting.

The Patent Office has given Manson an opportunity to show that his product is useful. Although that is his obligation he has been either unable or unwilling to do so. Therefore, the Patent Office quite properly rejected his application and should be affirmed.

I am aware of no authority for the novel proposition that a process which produces a useless product is patentable. Such a premise is wholly contrary to the Constitution and I am satisfied Congress did not intend the statutes enacted thereunder to be so construed.

In *In re Oberweiger*, 28 CCPA 749, 115 F. 2d 826, 47 USPQ 455, this court quoted with approval an earlier statement from *In re Perrigo*, 18 CCPA 1323, 48 F. 2d 965, 9 USPQ 154:

Neither the Patent Office tribunals nor the court may properly grant patents upon a mere possibility that a device might do the things claimed for it and be useful. There must be definiteness. Neither the Constitution nor the statutes contemplate the granting of patents upon theories, nor giving a monopoly upon intellectual speculations embodied in devices incapable of scientific analysis.

In *Libbey Owens v. Celanese*, 57 USPQ 258, the Sixth Circuit Court of Appeals held:

Controlling is the fact that such method claims are limited to the use of plastic compositions, with the identical ingredients and in the proportions of the three product claims, which have been already held to be insufficiently disclosed and inoperative, and the process, therefore, lacks the further requisite of utility.

I appreciate the fact that Manson's product is a known compound which may—or may not—someday prove to be useful. However, for his process to possess the requisite statutory utility, it must presently be more than a mere invitation to others to determine that it is useful.

**United States Court of Customs
and Patent Appeals**

OCTOBER TERM, 1963

June 25, 1964

**IN THE MATTER OF THE APPLICATION OF ANDREW JOHN
MANSON**

Patent Appeal No. 7140

**Subject Matter: Preparation of 2-Methyl-17a-Lower-
Alkyland-rostan-17b-ol-3-Ones**

Serial No. 3,693

Said appeal having heretofore been brought on to be heard before the court and due consideration thereon having been had, it is—

ORDERED that the decision of the Board of Appeals be, and the same is hereby, reversed.

I, **GEORGE E. HUTCHINSON**, Clerk of the United States Court of Customs and Patent Appeals, do hereby certify that the above judgment and the attached opinion are true and correct copies of the judgment and opinion of said United States Court of Customs and Patent Appeals filed the 25th day of June, A.D. 1964, in the above-entitled appeal, as the same remain upon the files and records of said court.

WITNESS my hand and the seal of this court this 5th day of November, A.D. 1964.

GEORGE E. HUTCHINSON,

Clerk.

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